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HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			DENNISON, JERRY B	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/697,113
Filing Date: October 25, 2000
Appellant(s): BOUCHARD ET AL.

Louis Bouchard et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 December 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-20, and 22-27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,535,586	Cloutier et al.	12-1998
6,449,344	Goldfinger et al.	1-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-20, and 22-27 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 15 April 2004.

DETAILED ACTION

1. This Action is in response to Amendment Paper #7 of Application Number 09/697,113 received on 01 April 2004.
2. Claims 1, 3-20, and 22-27 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier et al. (U.S. Patent Number 6,535,586), hereinafter referred to by Cloutier, in view of Goldfinger et al. (U.S. Patent Number 6,449,344) hereinafter referred to by Goldfinger.

3. Regarding claims 1 and 20, Cloutier discloses a system and method of providing message notification for a user comprising the steps of:

coupling a message notification application to a server, wherein the server stores messages for the user (Cloutier, col. 3, lines 50-61, Cloutier discloses storing messages of a message recipient);

registering the message notification application to at least one instant messaging service (Cloutier, col. 4, lines 15-40, Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of devices capable of receiving a message, including a server in the case where an access device is a computer device such as a personal computer, meaning the messaging system service must be registered with the server in order to be able to communicate with it);

Cloutier also discloses alerting the user of the receipt of new messages, working in conjunction with other messaging system architectures (Cloutier, col. 3, lines 33-41).

However, Cloutier does not disclose accessing one of the at least one instant messaging service by the user;

signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

sending an instant message notification from the message notification application via the one instant message service to the user when a message arrives on the server for the user.

In an analogous art of the networking field, Goldfinger discloses a communication system using including accessing one of the at least one instant messaging service by the user (Goldfinger, col. 5, lines 35-50, Goldfinger teaches notifying that the user is connected to the system);

signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing (col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system); and

sending an instant message via the one instant message service to the user when a message arrives on the server for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user).

Cloutier discloses a method and system for the remote notification and retrieval of electronically stored messages. Cloutier also discloses the notification system communicating with an external computer (Cloutier, col. 4, lines 30-40). Since Cloutier suggests that different methods of notification are possible (Cloutier, see Abstract, "a message alert, which may be implemented for a variety of media", col. 3, lines 39-41, Cloutier disclosed that the notification system may be combined with other messaging system architectures, col. 4, lines 15-40), this would have motivated a network administrator to explore the related art for differing types of messaging systems to use for notifying users of the system.

Goldfinger provides a system of instant messaging between users. Since Goldfinger discloses the term "user" as encompassing any entity, not just human, that operates a computer or other communications terminal, preferably for the purpose of connecting to and communicating via a communications network (Goldfinger, col. 2, lines 19-30), this would have motivated a network administrator to find uses for the instant messaging system with other communication systems such as the system of Cloutier.

Since Cloutier suggests what Goldfinger provides, a network administrator would have motivation to incorporate the teachings of Goldfinger into the notification system of Cloutier, providing another type of notification, to notify clients that a message has been received.

Therefore it would have been obvious for a network administrator at the time of the invention to combine the system for notification and retrieval of electronically stored messages, as disclosed by Cloutier (Cloutier, col. 3, lines 20-40), with the communication system using an instant messaging service, as disclosed by Goldfinger (Goldfinger, col. 1, line 64 through col. 5, line 25) to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user, for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

4. Regarding claims 3 and 22, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claim 1 and 20, including retrieving the message by accessing the server (Goldfinger, col. 6, lines 40-45, Goldfinger teaches the server sending a message after checking if the user is still connected). Cloutier also shows subscriber given the capability of retrieving messages from the messaging server (Cloutier, col. 4, lines 25-30). See motivation for claims 1 and 20.

5. Regarding claims 4 and 23, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claim 3 and 22, including wherein the server is one of an application, a voice messaging and a unified messaging server (Goldfinger, col. 5, lines 30-35). Cloutier also discloses that the enhanced messaging system provides for translation of messaging formats so that a user can retrieve virtually any type of message over any type of communication medium (Cloutier, col. 2, lines 45-50). See motivation for claims 1 and 20.

6. Regarding claims 5 and 24, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claim 3 and 22, including accessing the server by one of sending a request to the message notification application and using a telephone (Goldfinger, col. 5, lines 24-30). Cloutier also discloses wherein the user interface may be an interactive voice response system in the case where access device is a telephone (Cloutier, col. 4, lines 30-35). See motivation for claims 1 and 20.

7. Regarding claims 6 and 25, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claim 3 and 22, including retrieving messages from the server by an internet appliance (Goldfinger, col. 5, lines 25-30). Cloutier also discloses where the access device could be replaced with a personal computer connected to the messaging system server over an Internet (Cloutier, col. 4, lines 17-22). See motivation for claims 1 and 20.

8. Regarding claims 7 and 26, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claim 3 and 22, including deleting a message using an internet appliance without retrieving the message from the server (col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages). Cloutier also discloses that the enhanced messaging services are transparent to the typical messaging services (Cloutier, see Abstract) meaning that users may use the standard functions of their messaging system. Standard messaging systems include the deletion of messages without retrieving the message from the server. See motivation for claims 1 and 20.

9. Regarding claims 8 and 14, Cloutier discloses an apparatus and system for providing message notification and allowing a user to instantly review new messages comprising:

a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list

onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using (Cloutier, col. 4, lines 15-40, Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of devices capable of receiving a message); and

a server for storing messages and providing a medium for the message notification application to operate (Cloutier, col. 3, lines 50-61).

Cloutier does not disclose an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user

In an analogous art in the networking field, Goldfinger discloses at least one instant messaging service (Goldfinger, col. 4, lines 49-60); and

an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user (col. 6, lines 50-65, Goldfinger teaches users on a computer terminal being able to receive messages). Goldfinger also teaches users having a list of sought users (col. 6, lines 3-15). See motivation for claims 1 and 20.

10. Regarding claims 9 and 15, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claims 8 and 14, including further comprising means for automatically adding the user to the buddy list of the message notification

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application in response to the user signing up to receive messages with the message notification application (Goldfinger, col. 5, line 35 through col. 6, line 25, Goldfinger teaches a list of users updated when they sign on to the system). Cloutier also discloses subscribers to the message notification service (Cloutier, col. 3, lines 23-27). See motivation for claims 1 and 20.

11. Regarding claims 10 and 16, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claims 8 and 14, including wherein the message notification application comprises means for sending the user the instant message notification through the at least one instant messaging service when a message arrives for the user (Goldfinger, col. 6, lines 35-50). Because Cloutier suggests that different methods of notification may be used (Cloutier, see Abstract, "a message alert, which may be implemented for a variety of media", col. 4, lines 15-40), it would have been obvious for one in the ordinary skill in the art to incorporate the instant messaging system of Goldfinger as another way of notifying the recipient that a new message has arrived at the messaging server. See motivation for claims 1 and 20.

12. Regarding claims 11 and 17, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claims 8 and 14, including retrieving the message from the server by one of sending a request to the message notification application and using a telephone (Goldfinger, col. 5, lines 24-30). Cloutier also discloses wherein the user interface may be an interactive voice response system in the

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case where access device is a telephone (Cloutier, col. 4, lines 30-35). See motivation for claims 1 and 20.

13. Regarding claims 12 and 18, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claims 8 and 14, including wherein the server is one of an application, a voice messaging and a unified messaging server (Goldfinger, col. 5, lines 30-35). Cloutier also discloses that the enhanced messaging system provides for translation of messaging formats so that a user can retrieve virtually any type of message over any type of communication medium (Cloutier, col. 2, lines 45-50). See motivation for claims 1 and 20.

14. Regarding claims 13 and 19, Cloutier and Goldfinger disclose the limitations, substantially as claimed, as described in claims 8 and 14, including deleting the message using the Internet appliance without retrieving the message from the server (Goldfinger, col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages). Cloutier also discloses that the enhanced messaging services are transparent to the typical messaging services (Cloutier, see Abstract) meaning that users may use the standard functions of their messaging system. Standard messaging systems include the deletion of messages without retrieving the message from the server. See motivation for claims 1 and 20.

15. Regarding claim 27, Cloutier discloses a method of providing a voice messaging notification application (Cloutier, see Abstract) for a user in an instant messaging system comprising the steps of:

- coupling a message notification application to a server, wherein the server stores messages for the user (Cloutier, col. 3, lines 50-61 and col. 4, lines 34-37) ;

- registering the message notification application to at least one instant messaging service (Cloutier, col. 4, lines 15-40, Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of devices capable of receiving a message, including a server in the case where an access device is a computer device such as a personal computer, meaning the messaging system service must be registered with the server in order to be able to communicate with it);

- However, Cloutier does not disclose accessing one of the at least one instant messaging services by the user;

- adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service;

- sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user; and

- allowing the user access to a server by one of using an internet appliance and using a telephone.

In an analogous art in the networking field, Goldfinger discloses adding the user to a buddy list of the message notification application, wherein the buddy list is

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associated with the one instant messaging service (Goldfinger, col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system);

sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user (Goldfinger, col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user); and

allowing the user access to a server by one of using an internet appliance and using a telephone (Goldfinger, col. 5, lines 24-30).

Goldfinger also teaches users having a list of sought users (col. 6, lines 3-15).

See motivation for claims 1 and 20.

16. Since Cloutier and Goldfinger taught all the limitations in claims 1, 3-20, and 22-27, claims 1, 3-20, and 22-27 are rejected.

(11) Response to Argument

Preface

Before the Issues are made, Applicant states that a clear distinction is made between the terms "instant message notifications" and "messages" in the specification. However, Examiner would like to point out that the interpretation of the claims, as currently presented, could be read in many ways. The term "message" is not explicitly defined in the claimed invention, and can therefore be interpreted as any type of message. For

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example, "message" could be interpreted as an instant message, which means the claimed invention could be interpreted as a standard instant messaging system, where a user sends an instant message, which is temporarily stored at the server, and the server notifies the recipient that he/she is receiving the instant message. This has been pointed out in past Actions.

The Appellant argues (4) different issues.

Issue 1: Whether there is proper motivation to combine the system of Goldfinger with the messaging system of Cloutier.

As stated in the rejection, Cloutier discloses a method and system for the remote notification and retrieval of electronically stored messages. Cloutier also discloses the notification system communicating with an external computer (Cloutier, col. 4, lines 30-40). Since Cloutier suggests that different methods of notification are possible (Cloutier, see Abstract, "a message alert, which may be implemented for a variety of media", col. 3, lines 39-41, Cloutier disclosed that the notification system may be combined with other messaging system architectures, col. 4, lines 15-40), this would have motivated a network administrator to explore the related art for differing types of messaging systems to use for notifying users of the system.

Goldfinger provides a system of instant messaging between users. Since Goldfinger discloses the term "user" as encompassing any entity, not just human, that operates a computer or other communications terminal, preferably for the purpose of connecting to and communicating via a communications network (Goldfinger, col. 2,

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lines 19-30), this would have motivated a network administrator to find uses for the instant messaging system with other communication systems such as the system of Cloutier.

Since Cloutier suggests what Goldfinger provides, a network administrator would have motivation to incorporate the teachings of Goldfinger into the notification system of Cloutier, providing another type of notification, to notify clients that a message has been received.

Therefore it would have been obvious for a network administrator at the time of the invention to combine the system for notification and retrieval of electronically stored messages, as disclosed by Cloutier (Cloutier, col. 3, lines 20-40), with the communication system using an instant messaging service, as disclosed by Goldfinger (Goldfinger, col. 1, line 64 through col. 5, line 25) to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user, for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

Issue 2: Whether the proposed combination of Cloutier in view of Goldfinger results in a viably functioning system.

As stated above, Cloutier suggests that other types of messaging systems may be used to provide notification to the clients (Cloutier, col. 3, lines 39-41, Cloutier

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disclosed that the notification system may be combined with other messaging system architectures, col. 4, lines 15-40).

Goldfinger provides a type of messaging system that includes instant messaging (Goldfinger, Fig. 3, col. 1, line 64 through col. 5, line 25).

Combining Goldfinger with Cloutier does not change the functionality of either invention. Cloutier suggests that other types of messaging systems may be used in order to notify clients, and Goldfinger provides this messaging system. Therefore, Cloutier is simply enhanced to include another messaging system to perform the same functionality.

Issue 3: Whether Cloutier, Goldfinger, or their proposed combination teaches, "registering a message notification application to at least one instant messaging service", as claimed.

As stated in the above rejection, Cloutier discloses that the notification messaging system may be implemented with access devices including a separate server or computer device such as a personal computer (Cloutier, col. 4, lines 15-40) and therefore would have to include being registered with the separate server in order to communicate with it. Cloutier also discloses that the notification and remote retrieval aspects may be combined with other messaging system architectures (Cloutier, col. 3, lines 37-41), and therefore would require the notification system to be registered with these other messaging system architectures.

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Issue 4: Whether Cloutier, Goldfinger, or their proposed combination teaches, “signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing.”

As stated above, the proper motivation to combine Cloutier and Goldfinger discloses this limitation. Because the “users” in Goldfinger encompass any entity, not just human, that operates a computer or other communications terminal, preferably for the purpose of connecting to and communicating via a communications network (Goldfinger, col. 2, lines 19-25), it would have been obvious to one in the ordinary skill in the art to include the teachings of Goldfinger to provide a buddy list for the message notification application (meaning the message notification application acts as a user of Goldfinger) so that the message notification application can determine when users are signed on to the system and are able to retrieve instant messages.

In the case of the combination of Cloutier and Goldfinger, the “user” would represent the notification system. Each “user” of Goldfinger includes a buddy list of all users of interest, thereby associating each user to the one instant messaging service which the user is currently accessing.

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Appellants arguments also include the following:

Claims 1 and 3-7

Regarding claim 1, Issues 1-4 addressed again. Claims 3-7 are dependent on claim 1.

Claims 1 and 3-7 are rejected as discussed above.

Claims 8 and 9-13

Regarding claim 8, Issues 1-4 addressed again. Claims 9-13 are dependent on claim 8.

Claims 8 and 9-13 are rejected as discussed above.

Claims 14 and 15-19

Regarding claim 14, Issues 1-4 addressed again. Claims 15-19 are dependent on claim

14. Claims 14 and 15-19 are rejected as discussed above.

Claims 20 and 22-26

Regarding claim 20, Issues 1-4 addressed again. Claims 22-26 are dependent on claim

20. Claims 20 and 22-26 are rejected as discussed above.

Claim 27

Regarding claim 27, Issues 1-4 addressed again. Claim 27 is rejected as discussed

above.

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For the above reasons, it is believed that the rejections should be sustained.

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